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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
CHAMPAGNE, DONALD	

ART UNIT	PAPER NUMBER
3622	

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07/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/971,793	Applicant(s) BRODIE ET AL.	
	Examiner Donald L. Champagne	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the second line of each claim, "research" is new matter.
3. The specification supports "reaction enabling analysis tools" (in claim 6) and "reaction enabling computational tools" (para. [0019]), but does not disclose "research tools". Claim 3 discloses a "research report", but one of skill in the art would not find that that supports "research tools".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the second line of each claim, "research and computational" lacks antecedent basis. This rejection can be overcome by replacing that phrase with – analysis --.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

7. Claims 1-22 are rejected under 35 U.S.C. 103(a) as unpatentable over Payne et al. (US005715314A) in view of Matyas, Jr. (US006102287A).

8. Payne et al. teaches (independent claims 1 and 19) a method for providing one or more advertising messages, which reads on alerts, over a network, the method comprising the steps of:

composing one or more alert messages/*advertisements* that are sent to alert database/*advertisement database 18* (col. 2 line 67 to col. 3 line 3 and col. 4 lines 52-54);

using the *network 10*, which reads on using network links, for gathering a plurality of reaction enabling analysis tools (said tools including the *plurality of digital advertisements*, col. 1 line 1, gathered as a result of one or more searches – *computer 20* must search *database 18* for the ad, which reads on a document with relevant data), for a user to use in a collaborative manner with other users (i.e., in conjunction or collaboration with other users of the Fig. 1 sales system) to respond to the respective alert (i.e., to buy something suggested by the ad, col. 5 lines 27-28);

using data extracted from the alert database/*advertisement database 18*, to dispatch the alert messages and corresponding reaction enabling analysis tools to one or more of the clients over the network (col. 4 lines 60-63), the alert messages and corresponding reaction enabling analysis tools allowing contact with the facilities useful in responding to the alert (again, the user buying something online, col. 5 lines 27-28). For claim 19, the search and pricing/accounting tools (col. 5 lines 5-15) taught by Payne et al. read on “research and computational” tools.

9. Payne et al. does not teach determining a reaction to said alerts, comprising

users who have received the alert message and corresponding reaction enabling analysis tools cooperating with each other in conducting analysis by using the reaction enabling analysis tools to determine a reaction to said alert.

Matyas, Jr. teaches determining a reaction to said alerts, comprising the limitation given above, by providing product evaluation information (said providing being a reaction to said alert messages/*advertisements*) to potential buyers, said product evaluation information

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being derived from surveys of previous buyers (col. 2 line 63 to col. 3 line 2), which reads on conducting analysis by using the reaction enabling analysis tools to determine a reaction to said alert. Because Payne et al. teaches an electronic payment system (col. 3 lines 38-39) and Matyas, Jr. teaches that its invention enhances an electronic payment system (col. 3 lines 2-6), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Matyas, Jr. to those of Payne et al.

10. Payne et al. also teaches at the citations given above claims 2, 3, 5, 6, 8, 10-13, 14 (where the community of interest is the users of the WWW), 15, 16 and 20.
11. Payne et al. also teaches claim 4 (col. 5 line 17, where the user request reads on a human decision); claim 7, where the *shopping cart database 21* and the *settlement database 22* (col. 5 lines 5-15) read on databases of client information, claim 9, where the contents of the *shopping cart database 21* read on a set of preferences of each user, and claim 18 (col. 6 lines 43-44).
12. Payne et al. also teaches claims 21 and 22 at the citations given above and at col. 7 lines 5-13. All the users collaborate (para. 16-18 below) in real time to research, analyze and compute prices for possible purchases. As noted in para. 8 above, the reaction enabling analysis/research/computational tools include the *plurality of digital advertisements*.
13. Neither reference teaches (claim 17) providing a message if a user frequently declines to respond to ads/alerts, which reads on an infrequent customer. Because special advertising and promotions are commonly used to entice infrequent customers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the transmission of such special advertising and promotions, which reads on providing a message, to the teachings of Payne et al. and Matyas, Jr.

Response to Arguments

14. Applicant's arguments filed with an amendment on 26 March 2007 have been fully considered but they are not persuasive.
15. Applicant argues, that

"The purchasers in Matyas, Jr. do not cooperate with one another. There simply is no interaction between them in solving a problem in response to an alert." (P. 10, center, emphasis added.)

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Claim 1 is limited to users "cooperating". Applicant associates "cooperating" with "interacting", which is a matter of interpretation.

16. **Note on interpretation of claim terms** - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.
17. The instant application contains no such clear definition for the term "cooperating". Indeed, this word does not appear in the disclosure. It was introduced to claim 1 by an amendment filed on 21 August 2006. In the instant case, the examiner is required to give the term "cooperate" its broadest reasonable interpretation. "Cooperate" is supported by numerous references to "collaboration" in the spec. (including in claim 1). Both "collaborate" and "cooperate" share the meaning "to work together" (Merriam-Webster's Collegiate® Dictionary, 10th ed.). The examiner judges that "to work together" is the appropriate interpretation of "cooperate" in this case. Matyas, Jr., does teach the purchaser/users cooperating with one another in the sense of working together, so it reads on the claim.
18. "Cooperate" does have another meaning, "to act together", and "interact" is related to this meaning (Merriam-Webster's Collegiate® Dictionary, 10th ed.). But this sense of "cooperate" is not acceptable. "To act together", meaning "to interact", is not a meaning of "collaborate". The words "cooperate" and "interact" have no support in the spec. except through "collaborate", so this meaning would be new matter, and is therefore not acceptable.
19. Applicant also argues (p. 11, top of last para.), "there is no teaching in Payne et al. of using network links". The rejection (para. 3) says otherwise. Applicant denies the rejection without addressing it. This fails to comply with 37 CFR 1.111(b) because applicant's

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arguments amount to a general allegation that the claims define a patentable invention without distinctly and specifically pointing out the supposed errors in the examiner's action.

20. With the exception cited below, applicant similarly denies the rejection of each dependent claims (pp. 2-16) without distinctly and specifically pointing out the supposed errors in the examiner's action. For example, applicant alleges (p. 13, 2nd para.) that Payne et al. does not teach claim 2. Claim 2 limits the tool gathering to "one or more of a manual process and automatic process and the combination of manual and automatic processes." But, there are no alternatives other than manual, automatic, or some combination thereof. Any reference(s) that teach or suggest claim 1 must logically also teach or suggest claim 2.
21. Applicant argues (p. 15, center), "there is nothing in Payne et al. that teaches or suggests that other users of the www or a friend should be consulted in helping to make a decision." That explanation is unnecessary and has been deleted. Neither "expert" nor "subject matter of the alert" are given "clear definition" in the spec. The examiner interprets the limitation as being taught by any other user.

Conclusion

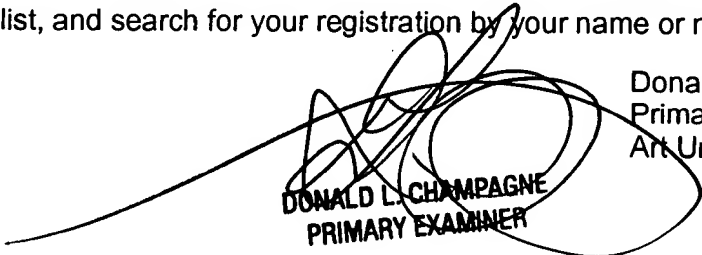
22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal*

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fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.

25. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
27. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
28. Applicant may have after final arguments considered and amendments entered by filing an RCE.
29. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

23 June 2007


DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
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Art Unit 3622